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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,073	04/19/2000	Adam Coyle	34250-1026	3055
29052 7590 05/05/2009 SUTHERLAND ASBILL & BRENNAN LLP 999 PEACHTREE STREET, N.E. ATLANTA, GA 30309				
EXAMINER COLBERT, ELLA				
ART UNIT 3696		PAPER NUMBER		
MAIL DATE 05/05/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/552,073

**Applicant(s)**

COYLE ET AL.

**Examiner**

Ella Colbert

**Art Unit**

3696

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-84 and 118-129 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 26-84 and 118-129 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 26-84 and 118-121 are pending in the communication of 02/05/09 entered as Correspondence Address Change.
2. The Change in Power of Attorney filed 10/16/08 has been entered.
3. The Change in Correspondence Address filed 10/08/08 has been entered.
4. The Response After Non-Final Action filed 03/15/06 has been entered.

After a careful review of the claims a restriction has been found as set forth here below.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 26-47, drawn to a payment system of a licensed money transmitter with an account maintained at a regulated financial institution associated with the licensed money transmitter, the financial institution responsive to a deposit of a predetermined amount of funds by direct deposit, the licensed money transmitter responsive to a request for issuance of a negotiable instrument of predetermined amount and the notification of the direct deposit of funds swept into the transaction account for issuing a prepaid negotiable instrument , classified in class 705, subclass 35.
- II. Claims 48-57, drawn to a method for arranging for communication notifications between a regulated financial institution, detecting a direct deposit of funds into an account at the regulated financial institution, communicating a notification of the direct deposit of funds, sweeping the

total amount of the direct deposit of funds into a transaction account, receiving from an agent of the licensed money transmitter a communication comprising a request by the individual, in response to the request for issuance of the prepaid negotiable instrument, responding to a determination that the value of the requested prepaid negotiable instrument is not in excess of the balance of the transaction account, and in response to the issuance of the requested prepaid negotiable instrument debiting the balance of the transaction account., classified in class 705, subclass 40.

- III. Claims 58-84, drawn to a computer-controlled negotiable instrument system for a licensed money transmitter that maintains a network of agent terminals, an account maintained by a financial institution on behalf of the licensed money transmitter for receipt of direct deposits, an account sweep control module run by the computer system responding to a notification received via a data communications interface from the financial institution indicating a direct deposit of funds, communicating a debit posting message, crediting the predetermined deposit amount to a transaction account, a transaction control module run by the computer system operative in response to a request from a requesting source, determining whether the balance in the transaction account associated with the particular individual, determining the balance in the transaction account is associated with the particular individual, posting a debit of the

request predetermined amount in response to the receipt from the agent terminal of a notification, classified in class 705, subclass 42.

- IV. Claims 118-121, drawn to a method for at an agent of the licensed money transmitter providing the individual with an account number and a PIN, receiving at the financial institution a direct deposit of funds, communicating a notification message from the financial institution to the licensed money transmitter, sweeping funds in an amount corresponding to the direct deposit of funds in response to the direct deposit of funds at the financial institution, receiving a request from the agent for issuance of the prepaid negotiable instrument at the licensed money transmitter, receiving a request from the agent for issuance of the prepaid negotiable instrument at the licensed money transmitter, in response to the request for issuance of the prepaid negotiable instrument at the licensed money transmitter, and in response to verification at the licensed money transmitter of the account number and the PIN and that the balance of the transaction account equals or exceeds the predetermined amount requested for the prepaid negotiable instrument, classified in class 705, subclass 39.
- V. Claims 122-129, drawn to a computer controlled negotiable instrument payment system for use by a licensed money transmitter for a computer system operated by a licensed money transmitter, a data communications interface associated with the computer system for data communications

with a transaction system of a regulated financial institution, an account sweep control module run by the computer system responsive to a notification received via the data communications interface from the financial institution indicating a direct deposit of funds in a predetermined deposit amount into an account at the financial institution, communicating a debit posting message indicating the predetermined deposit amount, crediting the predetermined deposit amount to a transaction account, a data communications interface associated with the computer system for data communications with point of sale (POS) terminals operated by agents of the licensed money transmitter, the POS terminals comprising a negotiable instrument printer for issuing negotiable instruments, a transaction control module run by the computer system and operative, in response to a communication comprising a request via an agent POS terminal, determining whether the balance in the transaction account associated with the particular individual equals or exceeds the requested predetermined amount, in response to a determination that the balance in the transaction account associated with the particular individual equals or exceeds the requested predetermined amount, and in response to the receipt from the POS terminal of the issuance of the negotiable instrument in the requested predetermined amount, less any applicable transaction fees, posting a debit of the requested predetermined amount, classified in class 705, subclass 64.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV and V are unrelated and Inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different scopes, furthermore they have different modes of operation thus yielding different effects and are not capable of use together for the reason set forth.

Invention I has a payment system of a licensed money transmitter with an account maintained at a regulated financial institution associated with the licensed money transmitter and an account maintained by the licensed money transmitter.

Invention II has a method for arranging communication notifications between a regulated financial institution and detecting a direct deposit of funds into an account at the regulated financial institution.

Invention III has a computer-controlled negotiable instrument payment system for a licensed money transmitter that maintains a network of agent terminals and an account maintained by the financial institution on behalf of the licensed money transmitter for receipt of direct deposits.

Invention IV has a method for an agent of the licensed money transmitter to provide the individual with an account number and a PIN and to receive at the financial institution a direct deposit of funds then to communicate a notification message from the financial institution to the licensed money transmitter.

Invention V has a computer controlled negotiable instrument payment system for use by a licensed money transmitter for a computer system operated by a licensed money transmitter, a data communications interface associated with the computer system for data communications with a transaction system of a regulated financial institution, an account sweep control module run by the computer system responsive to a notification received via the data communications interface from the financial institution indicating a direct deposit of funds in a predetermined deposit amount into an account at the financial institution, communicating a debit posting message indicating the predetermined deposit amount, crediting the predetermined deposit amount to a transaction account, a data communications interface associated with the computer system for data communications with point of sale (POS) terminals operated by agents of the licensed money transmitter, and POS terminals comprising a negotiable instrument printer for issuing negotiable instruments.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;



- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

May 4, 2009